

13 JAN 2003



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In re Application of	:	
DUBOIS	:	DECISION ON
Application No.: 09/202,217	:	
PCT No.: PCT/FR97/01023	:	RENEWED PETITION
Int. Filing Date: 10 June 1997	:	
Priority Date: 11 June 1996	:	UNDER 37 CFR 1.47(b)
Attorney's Docket No.: 146.1307	:	
For: NEW DEVICES INTENDED FOR THE	:	
TRANSDERMIC ADMINISTRATION OF	:	
TRIMEGESTONE, THEIR PREPARATION	:	
PROCESS AND THEIR USE AS MEDICAMENTS	:	

This decision is in response to applicant's "RENEWED PETITION UNDER 37 CFR 1.47(b)" filed 16 July 2002.

BACKGROUND

On 10 June 1997, applicant filed international application PCT/FR97/01023, which claimed a priority date of 11 June 1996. A copy of the international communication was communicated to the United States Patent and Trademark Office from the International Bureau on 18 December 1997. A Demand for international preliminary examination in which the United States was elected, was filed on 31 December 1997, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 11 December 1998.

On 09 December 1998, applicant filed, in the United States Patent and Trademark Office (USPTO), a transmittal letter requesting entry into the U.S. national stage, which was accompanied by, *inter alia*, the requisite U.S. basic national fee.

On 21 September 1999, applicant filed a PETITION UNDER RULE 42. The petition was accompanied by: the petition fee; a declaration of Jean-Claude Vieillefosse setting forth facts entitled DECLARATION UNDER RULE 47 (hereinafter "first declaration of facts"); a declaration of Mr. Vieillefosse on behalf of and as agent for the non-signing inventor; and Exhibits A-F:
-Exhibit A, a declaration of designation of inventors signed by Mr. Dubois;

- Exhibit B, copy of French law;
- Exhibit C, copy of employment contract;
- Exhibit D, copy of letter written to Mr. Dubois on 09 November 1998;
- Exhibit E, copy of fax to Mr. Dubois sent on 02 December 1998; and
- Exhibit F, copy of letter forwarded to Mr. Dubois on 30 December 1998.

However, Exhibits A and D-F were not in the application file. Additionally, the listing of "Enclosures" in the petition did not include the documents corresponding to Exhibits A and D-F.

On 27 October 1999, the USPTO mailed applicants a NOTIFICATION OF MISSING REQUIREMENTS (PCT/DO/EO/905) and a NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION (PCT/DO/EO/917) which indicated that the oath or declaration was not properly executed, and set a one month time period for response.

On 04 November 1999, applicant filed a RESPONSE to the NOTIFICATION OF MISSING REQUIREMENTS stating that a petition under Rule 42 was filed on 21 September 1999. The RESPONSE included a postcard receipt. Note that this postcard receipt did not list the items which comprised Exhibits A and D-F.

On 09 March 2000, the USPTO mailed a decision indicating that the petition under 37 CFR 1.42 was dismissed because an oath or declaration by the legal representative of the deceased inventor had not been presented. The decision also discussed the petition and supporting documentation as it related to 37 CFR 1.47(b) for petitioner's information only.

On 06 April 2000, applicant filed a RENEWED PETITION UNDER 37 CFR 1.47(b). The renewed petition was accompanied by a second declaration of facts by Jean-Claude Vieillefosse and purportedly Exhibits A and D-F, which were missing from the submission of 21 September 1999. The sheet marked Exhibit A, however, is not a declaration of designation of inventors signed by Mr. Dubois but is rather an attestation certifying that Mr. Dubois was an employee of Hoechst Marion Roussel from 02 September 1985 to 31 December 1997. (It is also noted that Exhibits D and E were mislabeled.) English translations of Exhibits D-F were also provided. The renewed petition was also accompanied by an "Extract from the minutes of the Board of Executive Directors' deliberations dated Thursday 10 December 1998 at 2:00PM" and an English translation thereof.

On 27 July 2000, the USPTO mailed a decision dismissing applicants renewed petition under 37 CFR 1.47(b). Specifically, it was noted that factual proof that the inventor refuses to execute the application and proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application had not been provided.

On 14 June 2001, applicant submitted a facsimile transmission, which was treated as a petition under 37 CFR 1.181. The petition requested that the documents including, *inter alia*, the "RENEWED PETITION UNDER 37 C.F.R. 1.47(b)" submitted with the petition under 37 CFR

1.181 be accepted as having been filed with the USPTO on 18 December 2000. The submission was accompanied by, *inter alia*, a copy of the "RENEWED PETITION UNDER 37 C.F.R. 1.47(b)"; a copy of a request for a three-month extension of time; a copy of a credit card payment form authorizing the fee for a three-month extension of time; a third declaration of facts from Jean Claude Vieillefosse; and a copy of a date-stamped postcard receipt.

On 02 July 2001, the USPTO mailed a decision granting applicant's petition under 37 CFR 1.181 and dismissing applicant's renewed petition under 37 CFR 1.47. Specifically, it was noted that factual proof that the inventor refuses to execute the application and proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application had not been provided.

On 23 July 2001, applicant submitted a third renewed petition under 37 CFR 1.47(b).

On 14 December 2001, the USPTO mailed a decision dismissing applicant's renewed petition under 37 CFR 1.47. Specifically, it was noted that factual proof that the inventor refuses to execute the application and proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application still had not been provided.

On 08 February 2002, applicant submitted a fourth renewed petition under 37 CFR 1.47(b), which was accompanied by a fourth declaration of facts from Jean-Claude Vieillefosse.

On 16 May 2002, the USPTO mailed a decision dismissing applicant's renewed petition under 37 CFR 1.47. Specifically, it was noted that factual proof that the inventor refuses to execute the application and proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application still had not been provided.

On 16 July 2002, applicant submitted a fifth renewed petition under 37 CFR 1.47(b), which was accompanied by a fifth declaration of facts from Jean-Claude Vieillefosse.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. As indicated in the decision mailed 27 July 2000, applicants have satisfied items (1), (3), (4), and (6) above.

In regard to item (2), as indicated in the decision mailed 14 December 2001, the oral refusal (22 December 1998) referred to in the third declaration of Jean-Claude Vieillefosse was made

before Mr. Dubois was presented with the application papers (30 December 1998) (see first declaration of facts of Mr. Vieillefosse, bottom of page 2). Additionally, it has not been established that Mr. Dubois failed to respond to the application papers sent to him on 30 December 1998. The renewed petition filed 23 July 2001 urges that the application papers were originally submitted to Mr. Dubois on November 9, 1998 with Miss Louvet's letter of that date. However, there is nothing in the translation of that letter which suggests that the application papers were sent on that date. The renewed petition filed 08 February 2002 did not address this issue. The declaration filed 16 July 2002 states that "during telephone conversations between Mr. Vieillefosse and Mr. Dubois after the applications and assignments had been forwarded to him at his new place of employment, Mr. Dubois refused to execute the documents." This declaration of facts establishes, by a person with first-hand knowledge, an oral refusal by Mr. Dubois to execute the present application. The statement in the declaration of facts implies that Mr. Vieillefosse had received the application papers.

Regarding item (5), the decision mailed 16 May 2002 indicated that it had not been established that the employee was performing an inventive task which corresponded to his actual duties or was performing studies and research with which he had been explicitly entrusted. Applicant has provided another declaration of facts by Jean-Claude Vieillefosse. This declaration is sufficient to establish that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application. Also regarding item (5), the relationship between Aventis Pharma, Hoechst Marion Roussel and Roussel Uclaf has been explained and proof of the relationship has been provided. A new declaration by Aventis Pharma on behalf of and as agent for the non-signing inventor is not required. Accordingly, item (5) has been satisfied.

CONCLUSION

For the above reasons, applicants' renewed petition under 37 CFR 1.47(b) is **GRANTED**.

As provided in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.

This application is being forwarded to the National Stage Processing Branch of the Office

of PCT Operations to continue national stage processing of the application, including the accordation of a 371(c) date of 21 September 1999.



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For: NEW DEVICES INTENDED FOR THE TRANSDERMIC ADMINISTRATION OF
TRIMEGESTONE, THEIR PREPARATION PROCESS AND THEIR USE AS
MEDICAMENTS

Dear Mr. Dubois:

You are named as an inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(b) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

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